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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,882	03/19/2004	Stephen James Field	0119/0034	7153

21395 7590 10/14/2010
LOUIS WOO
LAW OFFICE OF LOUIS WOO
717 NORTH FAYETTE STREET
ALEXANDRIA, VA 22314

EXAMINER

ROY, BAISAKHI

ART UNIT	PAPER NUMBER
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3777

MAIL DATE	DELIVERY MODE
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10/14/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/803,882	Applicant(s) FIELD ET AL.	
	Examiner BAISAKHI ROY	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/18/10</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. In view of the arguments related to claims 9-11 and 15 filed on 6/28/10, PROSECUTION IS HEREBY REOPENED. A new rejection regarding claims 9-11 and 15 is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Tse Chen/

Supervisory Patent Examiner, Art Unit 3777

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 1, 3-8, 12-14, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Arterburn (4644977). Arterburn discloses a multi-layered, plastic catheter-like tube or shaft structure which includes non-gas or non-foamed layers and gas-filled or foamed layers (col. 2 lines 46-57). The tube includes a inner tube 18 or which is non-foamed layer and having a thickness of 0.015 inch and the tube includes a second layer 20 which is a foamed layer have a thickness between 0.04-006 inch (col. 4 lines 6-12). The foamed layer or the layer with the gas bubbles is formed by blowing an agent which causes tiny closed air pockets or gas bubbles 38 to be dispersed throughout the layer and therefore the bubbles or air pockets extend around the entire circumference and length of the device (col. 3 lines 23-27, fig. 1-5). Therefore Arterburn discloses a device which includes a inner layer of plastic and a second layer of plastic wherein one of the layers or the inner layer 18 is free of gas bubbles and the other layer or second layer 20 includes gas bubbles dispersed within the material of the other or outer layer and wherein the layer free of gas bubbles or the non-foamed layer is thinner than the other foamed layer with the gas bubbles. Arterburn also teaches said tube to include a foamed layer 14 and a non-foamed outer cover 16 and therefore includes a third layer on the outside of the second layer which is free of gas bubbles (col. 4 lines 13-23). The tube or hose structure may also be varied as shown in figure 4 which includes a three-layered hose with one foamed interlayer 42 and a inner layer 40 and outer layer 44 free of gas bubbles. Therefore the plastic multi-layered tube includes two non-foamed inner and outer layers that are free of gas bubbles and thinner than the foamed middle layer which includes the gas bubbles. The foamed layer of the tube

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allows the hose to be resistant to damage, protecting the inter-layers from contact with the fluid flowing through the hose and providing a smooth surface on the hose or tube. Therefore it is necessarily true that such a tube or catheter with a smooth, foamed inner-surface would allow increased visibility of the device or catheter under ultrasound imaging.

If the structure claimed is the same as the structure in the prior art, then the prior art structure must inherently be capable of performing whatever function is being claimed. In this case, all that is being claimed in the preamble is a medical device. That does not lend any structure whatsoever to the claimed invention. It just places it in a particular field of use. The same goes for the "to increase visibility of the device under ultrasound imaging" limitation. Since the hose in the prior art has the same exact structure as the hose claimed, then the hose in the prior art must be inherently capable of performing that function. Please refer to In re Schreiber scenario. See MPEP 2114. The term "medical device" in the preamble does not limit the device. Even if it did, the tube in the reference could be used in a medical environment if necessary. It is well known that a drinking straw or a ball point pen could be used in an emergency tracheotomy and "capable" of being used as medical devices. It would be no different for the plastic hose of Arterburn. The fact that it is structurally the same, inherently means it can be visualized under ultrasound.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arterburn in view of Bland et al. (6071580). Arterburn teaches of a gas-filled or foamed layer but does not teach of the dimensions of the foam. In the same field of endeavor Bland et al. teach of a open cell thermoplastic foam with pores sized of about 5 micrometers or more (col. 4 lines 15-22). Therefore it would be obvious to one of ordinary skill in the art to use the foam structure with pores of particular dimension of Bland et al. such that the Arterburn tube or hose device has the desired thickness, density and porosity.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arterburn in view of Smith (6840090). Arterburn does not teach of a transparent tube. In the same field of endeavor Smith teaches a plumbing system that incorporates a transparent hose 38 so that the plumber can determine visually whether there is water in the hose (col. 2 lines 30-34). This type of hose therefore allows material within the hose or tube to easily be viewed by the eye. It would have therefore been obvious to one of ordinary skill in the art to use the teaching by Smith to modify the teaching by Arterburn such that the material within the hose or tube is made easily visible to the user to for maintenance purpose and ensuring that undesired material does not penetrate inside the hose and ensure proper drainage through the hose.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BAISAKHI ROY whose telephone number is (571)272-7139. The examiner can normally be reached on M-F (7:30 a.m. - 4p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BR
/B. R./
Examiner, Art Unit 3737

/Tse Chen/

Supervisory Patent Examiner, Art Unit 3777